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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/581,894

08/21/2000

Tung Ming Fong

20146P

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7590

08/14/2002

MERCK AND CO INC  
P O BOX 2000  
RAHWAY, NJ 070650907

EXAMINER

KEMMERER, ELIZABETH

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 08/14/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/581,894

Applicant(s)

FONG ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the species of SEQ ID NO: 7 in Paper No. 11 (11 June 2002) is acknowledged. Upon further consideration, it is deemed that a search and examination of all sequences that are directed to a fragment of the human ART protein of amino acids 76-132 would not be an undue burden. Therefore, the following SEQ ID NOS: are being examined: SEQ ID NOS: 1-3, 6-8, 15 and 16. All of the claims read on these sequences.

### ***Status of Application, Amendments And/Or Claims***

The sequence listing submitted 05 April 2002 (Paper No. 8) was found to be free of errors and has been entered into the file.

The drawings have been approved by the examiner and the draftsman.

### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 371 and 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

***Claim Objections***

Claims 1, 2 and 4-16 are objected to because of the following informalities: the claims embrace on-elected inventions. Appropriate correction is required.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO97/43412. 20 Nov. 1997. Amgen Inc.

US 5766877 (STARK ET AL). Issued 16 Jun. 1998, filed 27 Nov. 1996.

US 6060589 (STARK ET AL). Issued 09 May 2000, filed 02 Mar. 1998.

US 6203995 B1 (STARK). Issued 20 Mar. 2001, filed 29 Jun. 1999.

Each of the four references disclose a C-terminal fragment of human ART from residue 79 to 132 (see SEQ ID NO: 8). The references' fragment has biological activity, in that it decreases the appetite of rats to which the peptide is fed. The instant invention's SEQ ID NOS: 1-3, 6-8, 15 and 16 all contain a C-terminal fragment of human ART from residue 76-132, and is shown to bind melanocortin receptors. The

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physiological effects of ART on appetite are thought to be mediated through the binding of ART to melanocortin receptors. Therefore, the references' peptide differs from the C-terminal fragment of human ART of SEQ ID NOS: 1-3, 6-8, 15 and 16 of the instant invention solely in that three amino acid residues are deleted at the N-terminus of the references' sequence relative to the instant invention's sequences. However, none of the prior art suggests the specific C-terminal fragment recited in the claims, which is amino acids 76-132 of human ART.

Given the minor nature of the remaining issues, Applicant is encouraged to contact the examiner upon review of the office action and the application in order to negotiate an allowance via examiner's amendment. Applicant is also encouraged to review whether or not an information disclosure statement will be filed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number is (703) 308-2673. The examiner can normally be reached on Mon. - Thurs., 6:30 to 4:00, and alternate Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne L. Eyler, Ph.D. can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

ECK  
August 9, 2002



ELIZABETH KEMMERER  
PRIMARY EXAMINER